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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,373	02/28/2002	Maurice Sharp	PALM-3781.US.P	3394
7590 09/01/2004 WAGNER, MURABITO & HAO LLP Two North Market Street, Third Floor San Jose, CA 95113			EXAMINER JASMIN, LYNDIA C	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 09/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,373

Applicant(s)

SHARP, MAURICE

Examiner

Lynda Jasmin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 June 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 5-13, 15-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13, 15-22 and 24-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

1. Amendment received June 8, 2004 has been acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-13, 15-22 and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Panofsky et al. (2002/0161476 A1), in view of Nielsen et al. (2002/0099658 A1).

Panofsky et al. discloses a networked software dispensing system having a bus (via USB, IrDA, or parallel port connector), a memory unit (solid state memory) coupled with the bus for storing a software program (such as digital files), a display device (interface screen 11 via 90) coupled with the bus, a communications interface (box 27) coupled with the bus for communicating with a portable electronic device (either a laptop or a personal digital assistant), a device for accepting a payment for the software program coupled with the bus (inserting coins, bills, or swiping a credit card), and a processor coupled with the bus for transferring the software program to the portable electronic device in response to the payment (via computer system locating at the vending machine or host terminal, box 46, lines 1-8). The communications interface is a wireless communications interface (box 93).

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Panofsky et al further discloses a network interface for communicating with a remote network server (box 47). The remote network server transmits additional software to the network interface for storage on the memory unit (box 32). The network interface communicates a backup configuration of the portable computer system to the remote network server (via uploading large files from the handheld device, box 50, lines 39-44). The display device displays, in conjunction with the backup configuration, an emulated version of the portable computer system box 50, line 25-38). The remote network server (via central server) archives an inactive software program for the portable computer system (via the online account). The remote network server transmits an updated version of the software program to the portable computer system (box 75). However, Panofsky et al. fails to explicitly disclose the display device displaying an emulation of the portable computer system.

Nielsen et al. discloses a self-service terminal (such as an ATM) with the concept of the terminal (12) having a display (52) and including means for accessing a mobile portable (30). The terminal includes portable device emulation means, whereby the terminal is operable to retrieve and display information intended for the portable device [box 43-44]. From this teaching of Nielsen et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the vending and dispensing of digital files with customize display on a screen of Panofsky et al. to include the displaying an emulation of the portable computer system taught by Nielsen et al. in order to retrieve and display information intended for a portable device.

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4. Applicant is reminded that functional recitation(s) using the word “for” (e.g. “for storing a software program,” “for communicating with a portable computer system,” “for displaying an emulation of an operating system used by said portable computer system” etc.) have been considered but are given little patentable weight¹ because they fail to add any structural limitations and are thereby regarded as intended use language. A recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) (“The manner or method in which such machine is to be utilized is not germane to the issue of patentability of the machine itself.”); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in this paragraph apply to all examined claims currently pending.

Response to Arguments

5. Applicant's arguments filed June 8, 2004 have been fully considered but they are not persuasive. Contrary to Applicant's belief, the prior art discloses all the structural elements of the claimed invention.

6. In response to applicant's argument that “neither Panofsky nor Nielsen teach or suggest a display device coupled with said, said display device for displaying an

¹ See e.g. *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983) (stating that although all

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emulation of an operating system used by said portable computer system as recited in claim 1 and similar claims 10 and 20", the Examiner notes that the recitation for displaying an emulation of an operating system used by said portable computer system is an intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. *If the prior art structure is capable of performing the intended use, then it meets the claim.* In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, it is the Examiner's position that Applicants are only claiming the component of a computer system and a network interface.

If Applicants desire to give the phrase greater patentable weight, the Examiner respectfully recommends Applicants remove "for" from the phrase where intended use is not desired. Like always, such amendments must not constitute new matter and must be supported in Applicant(s)' specification.

7. Applicant's argument having been found unpersuasive, the rejection has not been withdrawn.

limitations must be considered, not all limitations are entitled to patentable weight.).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work Millennium Ed. by Ron White; How Networks Work, Millennium Ed. by Frank J. Derfler et. al.; and How the Internet Works, Millennium Ed. by Preston Gralla are additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these three references are directed towards beginners (see e.g. "User Level Beginning . . ."), because of the references' basic content (which is self-evident upon review of the references), and after further review of the entire application and all the art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these three references are primarily directed towards those of low skill in this art. Because these three references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must-at the very least-be aware of and understands the knowledge and information contained within these three references.

White, Ron, How Computers Work, Millennium Ed. Que Corporation, 9/1999.

Derfler, Frank J. et. al. How Networks Work, Millennium Ed., Que Corporation, 1/2000.

Gralla, Preston, How the Internet Works, Millennium Ed., Que Corporation, 8/1999.

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9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

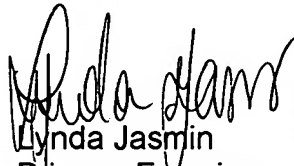
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda Jasmin whose telephone number is (703) 305-0465. The examiner can normally be reached on Monday- Friday (8:00-5:30) alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert P Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 8/30/04
Lynda Jasmin
Primary Examiner
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